

## **REMARKS**

### **I. Status of the Claims**

Claims 1-45 are present in the application. Of those claims, claims 13-16, 18, 19, 21-36, 39, 40, 42, and 43 have been withdrawn from further consideration in this application as being directed to non-elected subject matter. Thus, claims 1-12, 17, 20, 37, 38, 41, 44, and 45 are present in the application and pending on the merits. For at least the reasons outlined herein, Applicants respectfully request reconsideration and withdrawal of the claim rejections included in the Office Action of October 2, 2008 ("Office Action").

### **II. Claim Rejection under 35 U.S.C. § 112, First Paragraph**

In the Office Action, claims 37, 38, and 41 were rejected under 35 U.S.C. § 112, first paragraph, based on an assertion that the claims fail to comply with the written description requirement. Office Action at 2. In particular, with respect to claims 37 and 38, the rejection statement asserts that with respect to the geographical source of the hydrous kaolin recited, "the specification fails to set forth what characteristics of clays from [the Rio Capim area of Brazil] are necessary to achieve the basic and novel characteristics of the invention." Id. With respect to claim 41, the rejection statement asserts that "[t]he scope and meaning of the term 'defining step' is undefined." Id.

Applicants respectfully traverse the rejection and disagree with its assertions. According to M.P.E.P., "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed

invention." § 2163(l) (citations omitted). The M.P.E.P. advises that "the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." Id. § 2163.02. Further, "[t]he absence of definitions or details for well-established terms . . . should not be the basis of a rejection under 35 U.S.C. § 112, para. 1, for lack of adequate written description." Id. § 2163. In particular, "[i]nformation which is well known in the art need not be described in detail in the specification." Id. Applicants respectfully submit that the meaning of "hydrous kaolin obtained from the Rio Capim area of Brazil" and "defining step," as used in the context of the present application would have been understood by those skilled in the art.

Characteristics of "a hydrous kaolin obtained from the Rio Capim area of Brazil," as recited in independent claim 37, are well known to those skilled in the art of kaolin processing. For example, hydrous kaolins from the Rio Capim area of Brazil are known to possess narrow particle size distribution, to be platey, to be generally very bright, and to have unique coating rheology, relative to hydrous kaolins obtained from other geographical regions. See, e.g., U.S. Patent No. 6,312,511, at col. 5, lines 9-26, which has been cited in an Information Disclosure Statement filed concurrently herewith. In addition, "defining," as recited in claim 41, refers to a well known step for removing undesirable platey fine particles at the finer end of the particle size spectrum, and this term is well established in the art of kaolin processing. See, e.g., U.S. Patent No. 6,402,826, at col. 5, lines 22-25, which has also been cited in the Information Disclosure Statement.

For at least the above-outlined reasons, Applicants respectfully submit that claims 37, 38, and 41 comply with the written description requirement under 35 U.S.C. § 112, first paragraph, as outlined in the M.P.E.P. Therefore, Applicants respectfully request reconsideration and withdrawal of the claim rejection under 35 U.S.C. § 112, first paragraph.

**III. Claim Rejection under 35 U.S.C. § 102(b) Based on Slepetyts**

Claims 1-7, 12, 17, 20, 37, 38, 41, 44, and 45 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,393,340 to Slepetyts et al. ("Slepetyts"). Office Action at 2. Claims 1, 37, 41, and 44 are the only independent claims included in that claim rejection, and Applicants respectfully traverse the rejection of independent claims 1, 37, 41, and 44 based on Slepetyts because Slepetyts fails to disclose, either expressly or inherently, all of the subject matter recited in each of those independent claims.

According to the M.P.E.P., "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." § 2131 (citation omitted). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Id. (citation omitted).

For at least the reasons outlined below, Applicants respectfully submit that Slepetyts does not expressly or inherently disclose all of the subject matter recited in each of independent claims 1, 37, 41, and 44, or dependent claims 2-7, 12, 17, 20, 38, and 45, of the present application. Thus, the rejection of those claims under 35 U.S.C. § 102(b) based on Slepetyts should be withdrawn.

**A. Independent claim 1**

Applicants' independent claim 1 is directed to a composition comprising calcined kaolin, wherein, *inter alia*, "the calcined kaolin has a median particle size ranging from at least about 1  $\mu\text{m}$  to about 3  $\mu\text{m}$  . . . ." Slepetys fails to disclose at least this subject matter recited in independent claim 1.

The rejection statement asserts that "[t]able VI of [Slepetys] discloses a number of calcined kaolin (metakaolin) products . . . having median particle size distributions that round to 1 micron." Office Action at 2-3.

Applicants respectfully traverse the rejection and disagree with its assertions for a number of reasons. Table VI of Slepetys discloses fine-particle calcined kaolin products with median particle sizes ranging from 0.66 to 0.79 micron. The reference discloses 0.65 to 0.80 micron as the preferred median particle size range. Slepetys, col. 3, line 8. Those skilled in the art of calcined kaolins would readily recognize that a median particle size of 0.79 micron, or even 0.80 micron, is not equivalent to "at least about 1  $\mu\text{m}$ ," and that median particle sizes varying by about 0.20 micron or more may possess dramatically different properties and/or uses. Therefore, a person skilled in the art would understand that disclosure of a kaolin having a median particle size of 0.79 micron, or even 0.80 micron, does not result in express or inherent disclosure of a kaolin having a median particle size of "about 1 micron," as recited in independent claim 1.

Applicants further submit that Slepetys repeatedly discloses that its invention is directed to calcined kaolins characterized by finer particle size range, emphasizing that

such kaolin pigments are "significantly more valuable." Slepetyts, col. 3, lines 39-40; see also col. 4, lines 22-25; col. 7, lines 60-62.

For at least the above-outlined reasons, Applicants respectfully submit that Slepetyts does not disclose, either expressly or inherently, all of the subject matter recited in independent claim 1. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 102(b) based on Slepetyts.

#### **B. Independent Claim 37**

Applicants' independent claim 37 is directed to a composition including calcined kaolin, wherein, *inter alia*, "the composition is formed from a hydrous kaolin obtained from the Rio Capim area of Brazil." Slepetyts fails to disclose at least this subject matter recited in independent claim 37.

The rejection statement asserts that "there is no evidence of record that the geographical source of the raw materials used to form the claimed end product produces a materially different product from that of the instant claims." Office Action at 3.

Applicants respectfully traverse the rejection and disagree with the assertion. As pointed out above, it is well known to those skilled in the art that hydrous kaolins obtained from the Rio Capim area of Brazil are materially different from kaolins mined from other geographical regions. For example, hydrous kaolins obtained from the Rio Capim region in Brazil may have a narrow particle size distribution, they may be platy, generally very bright, and may be characterized by fine particle sizes compared to, for

example, North American kaolins. Slepetys does not disclose hydrous kaolins possessing such characteristics, and thus does not expressly or inherently disclose this subject matter.

For at least these reasons, Applicants respectfully submit that Slepetys does not disclose, either expressly or inherently, all of the subject matter recited in independent claim 37. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 37 under § 102(b) based on Slepetys.

### **C. Independent Claim 41**

Applicants' independent claim 41 is directed to a composition including calcined kaolin, wherein, *inter alia*, "the total of alkali and alkaline earth metals present in the composition is less than or equal to about 1.0% by weight, relative to the total weight of the composition . . . ." Slepetys fails to disclose, either expressly or inherently, at least this subject matter recited in independent claim 41.

After conceding that in Slepetys "there is no disclosure of significant alkali or alkali metal content," the rejection statement asserts that "there is no evidence of record that the particular raw material employed necessarily results in an end product materially different from that of the prior art relied upon." Office Action at 3. The rejection statement also asserts that Slepetys teaches "that the material should be free of other minerals including alkali metals." Id.

Applicants respectfully traverse the rejection and disagree with its assertions. A reference's silence as to a particular attribute of a product claim does not result in express or inherent disclosure that the claimed product does not include or possess that

attribute, particularly when one of ordinary skill in the art would readily understand that attribute to be inherent. In the present case, an artisan skilled in the art of kaolin-containing compositions would understand that kaolins may have a wide range of alkali and alkaline earth metal content — typically over 2% and sometimes as high as 5%. For example, specification of the present application suggests that kaolins inherently have a high alkali and alkaline earth metal content that results in “detrimental impurities in some applications.” See paragraph [027]. Example 2 of the present application refers to a kaolin having alkali and alkaline earth metal impurities of at least 2.1%. See paragraph [055].

Slepetys does not expressly disclose the alkali or alkaline earth metal content of its disclosed kaolins. Thus, a person having ordinary skill in the art would understand that the kaolins disclosed in Slepetys could include a typical alkali or alkaline metal earth content of between 2 and 5%. Thus, merely because Slepetys fails to address the alkali or alkaline metal earth content does not mean that the kaolin disclosed in Slepetys necessarily has a content below 2%.

For at least the above-outlined reasons, Applicants respectfully submit that Slepetys does not disclose, either expressly or inherently, all of the subject matter recited in independent claim 41. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 41 under 35 U.S.C. § 102(b) based on Slepetys.

#### **D. Independent Claim 44**

Applicants' independent claim 44 is directed to a composition including calcined kaolin, wherein, *inter alia*, "the composition has a median particle size of at least about 1  $\mu\text{m}$  . . . ." For at least the reasons outlined above with respect to independent claim 1, Slepetys fails to expressly or inherently disclose at least this subject matter recited in independent claim 44. Thus, Slepetys does not anticipate independent claim 44 under 35 U.S.C. § 102(b). Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 44 under §102(b) based on Slepetys.

For at least the above-outlined reasons, Slepetys fails to disclose, either expressly or inherently, all of the subject matter recited in Applicants' independent claims 1, 37, 41, and 44. Thus, Slepetys cannot anticipate those claims under 35 U.S.C. § 102(b), or claims 2-7, 12, 17, 20, 38, and 45, which depend from a corresponding one of independent claims 1, 37, and 44. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-7, 12, 17, 20, 37, 38, 41, 44, and 45 under 35 U.S.C. § 102(b) based Slepetys.

#### **IV. Claim Rejection under 35 U.S.C. § 103(a)**

Claims 8-11 were rejected under 35 U.S.C. § 103(a) based on Slepetys. Office Action at 4. Claims 8-11 depend from independent claim 1, and thus, those dependent should be patentably distinguishable from Slepetys for at least the same reasons as independent claim 1. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of dependent claims 8-11 under 35 U.S.C. § 103(a) based on Slepetys.



**V. Conclusion**

For at least the reasons set forth above, independent claims 1, 37, 41, and 44 should be allowable. Dependent claims 2-12, 17, 20, 38, and 45 depend from one of the allowable independent claims 1, 37, and 44. Consequently, those dependent claims should be allowable for at least the same reasons as independent claims 1, 37, and 44. Further, withdrawn claims 13-16, 18, 19, and 21 depend from allowable independent claim 1. Thus, those withdrawn claims should also be allowable.

Applicants respectfully request reconsideration of this application, withdrawal of the claim rejections, rejoinder and examination of withdrawn claims 13-16, 18, 19, and 21, and allowance of pending claims 1-21, 37, 38, 41, 44, and 45.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicants' undersigned attorney at (404) 653-6559.

Applicants respectfully submit that the Office Action contains assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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